LIBRARY
SUPREME COURT, U. S.

Office-Supreme Court, U.S.
FILED
AUG 7 1964
JOHN F. DAVIS, CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1964

No. 266

JOHNS-MANVILLE CORPORATION,

Petitioner,

v.

ITALIT, INC.,

Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO A PETITION FOR A WRIT OF CERTIORARI

STANTON T. LAWRENCE, JR.,
ROBERT MCKAY,
330 Madison Avenue,
New York, New York 10017,
Attorneys for Respondent.

PENNIE, EDMONDS, MORTON,
TAYLOR & ADAMS,
Of Counsel.

ACKERMAN PRESS, Phones BO 9-7107-8

IN THE

Supreme Court of the United States

OCTOBER TERM, 1964

No. 266

JOHNS-MANVILLE CORPORATION,

Petitioner,

v.

ITALIT, INC.,

Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO A PETITION FOR A WRIT OF CERTIORARI

Statement

This is an ordinary patent infringement action. The patent relates to a pipe coupling—an art which both the Patent Office and the Court of Appeals recognized as highly developed (Petitio Appendix B, p. 6). The contested issues were the usual issues of validity and infringement of claims 1 and 2 of the patent in suit. Claim 1 is a specific claim, 446 words long. Claim 2 is dependent upon claim 1, adding 138 words to the restricting language of claim 1. Petitioner prevailed in the District Court upon both issues, the District Court adopting, with minor changes, findings and conclusions prepared by Petitioner's counsel.

The Court of Appeals affirmed the District Court on the finding of validity stating:

> "This finding of fact [Finding 20, Petition Appendix B, p. 5] cannot be set aside as clearly erroneous, and it warrants that the statutory requirements for patentability have been met" (Petition Appendix B, p. 6).

The Court of Appeals then proceeded to examine the history of the prosecution of the claims of the patent in suit. After a detailed comprehensive discussion of the claims and the manner in which they were amended and finally allowed, the Court concluded that the claims were not literally infringed by Respondent's coupling and that the language of the claims could not be expanded through the application of the doctrine of equivalents because of the nature of the art, the claim language and the history of the prosecution of the claims in the Patent Office. The Court of Appeals correctly followed the decision of this Court in *Keystone Co.* v. *Northwest Eng. Co.*, 294 U. S. 42 (1935) and reversed the District Court on the issue of infringement.

Petitioner now seeks by its petition to have this Court re-examine the issue of infringement.

Argument

There is no conflict between the decision of the Court of Appeals below and any decision of this Court. Instead, that Court followed the decision of this Court in the *Keystone* case, *supra*.

There is no conflict between the decision of the Court below and that of any other Court of Appeals.

The decision of the Court below turns upon the particular facts and circumstances regarding Respondent's

pipe coupling and does not involve any matters of public or general importance. Petitioner is in the same position as any other patent owner that has lost in the Court below.

The decision of the Court of Appeals is clearly correct on the basis of the history of the prosecution of the claims in the Patent Office, the language of the claims themselves and the stipulated structure of Respondent's pipe coupling. The relevant facts are discussed by the Court of Appeals (Petition Appendix B, pp. 6-12) in reaching the conclusion that the District Court "erred in finding that Claims 1 and 2 of the patent in suit have been infringed by the defendant, Italit" (Petition Appendix B, p. 12).

In "Question One" (Petition, p. 9 *et seq.*) Petitioner attempts to make a "constitutional" issue out of losing the case in the Court below. There certainly is no constitutional requirement that a Court of Appeals discuss in its opinion the *entire* evidence in making a decision. The Court of Appeals below discussed the relevant portions of the record and quite correctly concluded that the District Court had erred upon the issue of infringement. This can hardly give rise to a "constitutional" issue. Petitioner merely *lost* in the court below on a well-reasoned opinion discussing the relevant facts and applicable law.

"Question Two" (Petition, pp. 15-16) merely restates the same proposition as "Question One" without the "constitutional" issue.

In "Question Three" (Petition, pp. 17-19), Petitioner assumes that the Court of Appeals reversed the District Court because the findings and conclusions were prepared by counsel for the prevailing party. This is obviously not the fact because the Court below adopted the findings of the District Court on the validity issue as not clearly erroneous. The Court below found the findings of the District Court relating to the infringement issue clearly

erroneous upon the relevant facts which it discussed in its opinion. The applicable law regarding the fact finding function of the District Courts has been recently stated by this Court in *United States* v. *El Paso Gas Co.*, 376 U. S. 651 (1964) and by the Court of Appeals for the Fifth Circuit in *Louis Dreyfus & Cie.* v. *Panama Canal Company*, 298 F. 2d 733, 737-9 (5 Cir. 1962). These decisions are in complete harmony. The Court of Appeals in the decision below did not depart from these decisions.

CONCLUSION

For the foregoing reasons, it is respectfully submitted that the Petition for a writ of certiorari should be denied.

Respectfully submitted,

STANTON T. LAWRENCE, JR.,
ROBERT MCKAY,
330 Madison Avenue,
New York, New York 10017,
Attorneys for Respondent.

PENNIE, EDMONDS, MORTON,
TAYLOR & ADAMS,
Of Counsel.

New York, New York, August 6th, 1964.